

III. Remarks

Claims 1-4 and 6-24 are pending in this application. Claims 1-3 and 9-23 were previously withdrawn from further consideration. Claim 5 is cancelled herein without prejudice to pursuing this claim in a continuing application. Claim 26 has been added, support for which may be found at page 72, line 18-21 of the application as originally filed. Accordingly, Applicant respectfully submits that no new matter has been added. Upon entry of these amendments, claims 1-4 and 6-25 will be pending and under active consideration.

The Brief Description of the Drawings has been amended to identify the polypeptide sequences disclosed on FIGURE 1 as Cyr61, CEF10, Fisp12, CTGF, and Nov, support for which may be found at FIGURE 1, as originally filed. The Brief Description of the Drawings has also been amended to provide the appropriate SEQ ID NO for each polypeptide sequence disclosed on FIGURE 1. Accordingly, Applicant respectfully submits that no new matter has been added.

A. Patentability Arguments

1. Objections to Specification

a. The objection to the specification for failure to include SEQ ID NOs should be withdrawn.

At page 2 of Paper No. 28, the specification is objected to for failing to include a sequence identifier for the polypeptide sequences disclosed at FIGURE 1. FIGURE 1 discloses an alignment of related polypeptides Cyr61, CEF10, Fisp12, CTGF and Nov I. FIGURE 1 as originally filed does not include sequence identifiers for the disclosed polypeptide sequences. In accordance with MPEP 2422.02, sequence identifiers have been added to the Brief Description of the Drawings for each of the polypeptide sequences disclosed at FIGURE 1 in order to conform the disclosure of the sequences thereon to the relaxed requirements of drawing figures under 37 C.F.R. § 1.821(b). In view of the addition of sequence identifiers to the Brief Description of the Drawings, Applicant respectfully requests withdrawal of the objection to the specification for failure to include sequence identifiers for the polypeptide sequences disclosed at FIGURE 1.

b. The objection to the specification for failure to provide a sequence listing for the CEF10 and Nov polypeptides should be withdrawn.

At page 2 of Paper 28, the specification is objected to for failing to comply with the requirements set forth in 37 C.F.R. §§ 1.821-1.825. At page 2 of Paper No. 28, the Examiner alleged that the amino acid sequence of polypeptides CEF10 and Nov disclosed at FIGURE 1 were not included with the previously filed Sequence Listing. In accordance with 37 C.F.R. § 1.825, Applicant submits herewith a substitute Sequence Listing and a substitute copy of the computer readable form of the Sequence Listing. The substitute Sequence Listing includes the amino acid sequences of the CEF10 and Nov polypeptides as SEQ ID NOS: 33 and 34, respectively. In view of the submission of the substitute Sequence Listing herewith, Applicant respectfully requests withdrawal of the objection to the specification for failure to file a sequence listing for the CEF10 and Nov polypeptides.

2. 35 U.S.C. § 112, second paragraph

a. The rejection of claims 4, 6-8 and 24 as vague and indefinite for reciting the term Cyr61 should be withdrawn.

At page 3 of Paper 28, claims 4, 6-8 and 24 are rejected as vague and indefinite for reciting the term "Cyr61." Applicant respectfully traverses the rejection. Applicant respectfully submits that the Examiner has applied an improper standard of definiteness.

It is a fundamental principle that applicants are their own lexicographers. *See MPEP* § 2173.01; *In re Swinehart*, 160 USPQ 226 (CCPA 1971). Applicants can define in the claims what they regard as their invention in whatever terms they choose so long as the terms makes clear the boundaries of the subject matter for which protection is sought. *See MPEP* § 2173.01. The definiteness requirement of 35 U.S.C. § 112, second paragraph, is satisfied if the scope of the invention sought to be patented can be determined from the claim language with reasonable certainty. *See MPEP* § 2173.02; *In re Wiggins*, 179 USPQ 421 (CCPA 1973). The definiteness of claim language is considered in light of: (a) the specification; (b) the teachings of the prior art; and (c) the claim interpretation by one of ordinary skill in the art at the time the invention was made. *See MPEP* § 2173.02.

At page 3 of Paper 28, the Examiner alleges that the term "Cyr61" is indefinite because "binding characteristics [are] the sole means of identifying the molecule."

Applicant respectfully submits that the specification provides numerous teachings for one of ordinary skill in the art to reasonably ascertain the meaning of "Cyr61." For example, the specification discloses that Cyr61 is a secreted 41kDa polypeptide exhibiting 39 cysteine residues. *See* page 22, lines 19-26. The specification also discloses that Cyr61 is a member of a family of cyteine-rich secreted proteins including Fisp12, CTGF, CEF10, and Nov. *See* page 5, line 26 to page 6, line 5. Moreover, the specification discloses the amino acid sequence of representative Cyr61 polypeptides. *See* Figure 1. In view of the teachings of the specification, Applicant respectfully submits that one of ordinary skill in the art would be readily able to ascertain the scope of claims 4, 6-8 and 24 with reasonable certainty.

At page 3 of Paper 28, the Examiner further alleges that the use of only the laboratory designation "to identify a particular molecule renders the claims indefinite because different laboratories may use the same laboratory designation to definite completely distinct molecules." Applicant respectfully notes that the proper consideration is not whether the term "Cyr61" may be used by other parties. Instead, the proper inquiry is whether the teachings of the prior art are contrary to the claim language thereby making an otherwise definite claim take on an unreasonable degree of uncertainty. *See* MPEP 2173.03; *In re Cohn*, 169 USPQ 95 (CCPA 1971); *In re Hammack*, 166 USPQ 204 (CCPA 1970). The Examiner has failed to provide any evidence that the teachings of the prior art are inconsistent with Applicant's use of "Cyr61" in claims 4, 6-8 and 24. Moreover, the Examiner cited four references as prior art at pages 5-6 of Paper No. 10 which each refer to the polypeptide in question as "Cyr61." Furthermore, Applicant has submitted on Information Disclosure Statements the following references, which each refer to the polypeptide in question as "Cyr61": Latinkic *et al.* (C8), O'Brien *et al.* (C13), Yang *et al.* (C18) and Yang (C20). In view of the above references using the term "Cyr61" in the same manner as that of claims 4, 6-8 and 24, Applicants respectfully submit that one of ordinary skill in the art would be able to ascertain the scope of claims 4, 6-8 and 24 with reasonable certainty.

At page 3 of Paper 28, the Examiner suggests that the claims be amended to include SEQ ID NOs to refer to the Cyr61 polypeptides in order to "specifically and uniquely identify Cyr61." While Applicant acknowledges that according to *MPEP*

§ 2173.02, “Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used,” Applicant notes that under *MPEP* § 2173.02 the Examiner “should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.” For the reasons discussed above, Applicant respectfully submits that the use of “Cyr61” in claims 4, 6-8 and 24 satisfies the statutory requirement of 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 4, 6-8 and 24 as vague and indefinite for reciting the term “Cyr61.”

b. The rejection of claims 4, 6-8 and 24 as being incomplete for omitting essential steps should be withdrawn.

At page 3 of Paper 28, claims 4, 6-8 and 24 are rejected as being incomplete for omitting essential steps, such omission amounting to a gap between essential steps. Applicant respectfully traverses the rejection. Applicant respectfully submits that the Examiner has not properly interpreted claims 4, 6-8 and 24.

For interpreting claims during examination, the words of the claim are to be given the broadest reasonable meaning as understood by one of ordinary skill in the art while taking into account any definition provided by the specification. *See MPEP* § 2111; *In re Morris*, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

The preamble of claim 4 is drawn to “screening a modulator of cell migration.” Steps (a)-(e) are directed to assaying cell migration in the presence and absence of a suspected modulator. Cell migration is assayed in the absence of the suspected modulator to provide a control. *See* page 72, lines 7-8. Step (f) is directed to the identification of a modulator of cell migration by comparing the level of cell migration in the presence of the suspected modulator to the level of cell migration in the control. Step (f) recites that a modulator of cell migration is identified by “it ability to alter the level of cell migration” when compared to the control.

At page 4 of Paper No. 28, the Examiner alleges that there is no linking step to assaying the suspected modulator. The Examiner questions,

Does the modulation result in up-regulation of migration?
Down-regulation of migration? In other words, how is the
level of cell-migration altered?

See Id. The Examiner alleges that “the specification does not specifically define what is meant by altering the migration.” *See Id.*

Applicant respectfully submits that the specification specifically defines, at numerous instances, what is meant by “altering the migration.” In one exemplary embodiment of the invention, the specification at page 72, lines 9-12 discloses the following:

An increase in cell migration in the presence of the suspected modulator relative to cell migration in response to Cyr61 alone identifies a promoter of ... cell migration, while a relative decrease in cell migration in the presence of the suspected modulator identifies an inhibitor.

As disclosed in the specification, a modulator of cell migration may promote or inhibit cell migration. In other words, a modulator of cell migration may “alter” cell migration compared to the control of Cyr61 alone. Based on the explicit teachings of the specification, Applicant respectfully submits that one of ordinary skill in the art would be able to properly determine the metes and bounds of claims 4, 6-8 and 24.

Accordingly, Applicant respectfully request withdrawal of the rejection of claims 4, 6-8 and 24 under 35 U.S.C. § 112, second paragraph, for being incomplete for omitting essential steps.

B. Conclusion

In view of the above amendments and remarks, Applicants respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

KATTEN MUCHIN ZAVIS ROSENMAN

By: 

Teddy C. Scott, Jr., Ph.D.
Registration No.: 53,573

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KATTEN MUCHIN ZAVIS ROSENMAN
525 W. Monroe Street, Suite 1600
Chicago, IL 60661
(312) 902-5321 (Telephone)
(312) 577-4708 (Fax)